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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/366,749	08/04/1999	CHRISTOPHER THOMAS VOIGT	1330.1031/JR	3440

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EXAMINER

RIMELL, SAMUEL G

ART UNIT PAPER NUMBER

2166

DATE MAILED: 12/18/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

8X

Office Action Summary

Application No.

09/366,749

Applicant(s)

VOIGT ET AL.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: ____ |

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Newly submitted claim 22 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 22 defines a method for integrating healthcare systems. As such, claim 22 defines a species of method claim which is both independent and distinct from the species of method claims already present in the current application.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 22 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention lacks utility.

The reasons for this rejection were set forth in the office action of 3/29/01 and are hereby incorporated by reference.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 4-9 and 11-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Myers et al ('450).

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The reasons for this rejection were set forth in the office action of 3/29/01 and are hereby incorporated by reference.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al. ('450).

The reasons for this rejection were set forth in the office action of 3/29/01 and are hereby incorporated by reference.

Remarks

Rejections under 35 USC 112: These rejections have been withdrawn in light of applicant's amendment.

Rejection of claim 21 under 35 USC 101: Applicant argues that the rejection is improper by reason computer programs on computer readable medium now constitute statutory subject matter. This is certainly true, but this is not why the rejection was applied. The rejection is based on a logical disconnection between the preamble and the body of the claim. The preamble defines a physical structure (i.e. a storage medium) but the body of the claim only defines a process. Strictly speaking, a storage medium does not contain a "process", it contains computer code which is used to carry out a process. Thus, in claim 21, no patentable weight can be attributed to the process. Since the only portion of the claim carrying patentable weight is a storage medium with no additional physical structures rendering it capable of doing anything, the

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invention lacks utility. It is recommended that applicant recite the process as being embodied in computer code, in which instance, the rejection can be withdrawn.

Rejection of claims 1, 4-9 and 11-20 under 35 USC 102(e) as being anticipated by Myers et al. :

Applicant argues that Myers et al. lacks an integration interface. However, this was explicitly discussed in the first office action. Myers clearly discloses an integration interface in FIGS. 2A-2B.

With respect to claims 1, 14, 15, 17 and 18, applicant argues that the claim language calling for separate systems does not read on “physically separate systems”. Examiner maintains that claim language calling for a “separate system” would readily read on a physically separate system. The claims do not contain any exclusionary requirements.

With respect to claim 14, applicant argues that Myers et al. lacks an “application programming interface” that is separate from and simultaneously used by the healthcare system. By definition, an application programming interface is simply an interface between a computer operating system and the application programs in that computer. Any one of the document management systems 10, 12, 14 or 16 would inherently include an application programming interface as part of its operating systems. In addition, since these applications programming interfaces are part of the document management system, they are physically separate from the healthcare system computers (18, 20, 22).

Applicant further argues that the healthcare system of Myers et al. does not provide access “limited to patient records”. The only type of records which are disclosed by Myers et al. as being accessed are patient records, so it is quite clear that this limitation is met.

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Applicant further argues that the healthcare computers of Myers et al. can access image data, thus, the access is not limited to “patient records”. However, in Myers et al. it is quite clear that the images, such as those derived from imaging studies, are part of the overall medical record. If they were not part of the medical record, there would be no logical reason for these images to exist.

With respect to claims 19 and 20, applicant states that claims 19-20 recite a “non-integrated document management system” and argues that the document management system of Myers et al. cannot have such a configuration because it produces a unified encounter record. This argument appears to be a case of comparing “apples and oranges”. The physical arrangement of the document management system computers define a set of physically separate, non-integrated computers. This is not the same feature as the encounter record.

With respect to claims 1 and 20, applicant takes issue with examiner’s position that no patentable weight can be attributable to the process features of these claims. Examiner does not agree that this is contrary to the law or the two cases cited by applicant on this issue (page 6, 4th paragraph, of applicant’s arguments). The cases cited appear to have no bearing on this issue. The problem which occurs is that the preamble in these claims are defining the invention as a physical structure, not a process. Accordingly, any recitation of process steps would not be part of the invention, since processes are not physical structures.

Rejection of claims 2, 3 and 10 under 35 U.S.C. 103 as being obvious in view of Myers et al.:

With respect to claim 2, applicant argues that the step of logging on to a healthcare system is not the same as logging on to a management system. This is true, but this is not the

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issue of at hand. The issue is whether or not it would have been obvious to the person of ordinary skill in the art at the time of the invention to modify Myers et al. to incorporate a log on system to log on to the management computers and then use that information to log on to a larger network.

Examiner maintains that such log on features are very well known in the art, and are not merely the "personal knowledge" of the examiner, as alleged by applicant in the remarks.

MPEP 2144.04 states:

"If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such a notorious character that official notice can be taken, it is sufficient to so state. *In re Malcolm*, 129 F.2d 529, 54 USPQ 235 (CCPA 1942); *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970); *In re Seifreid* 407 F.2d 897, 160 USPQ 804 (CCPA 1969).

The rejections of claims 3 and 10 are directed to substantially different issues than those of claim 2. These issues are not addressed, and examiner maintains that the rejections as recited are proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.

A handwritten signature in black ink, appearing to read 'S. Rimell', is positioned above the printed name.

Sam Rimell
Primary Examiner
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